

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(MBHB Case No. 08-983-WO-US)**

In the Application of:)
Christophe Delesalle et al.)
) Examiner: Tung Q. Tran
Serial No.: 10/502,043)
Now U.S. Pat. No. 7,636,375)
) Group Art Unit: 2416
Filing Date: January 19, 2005)
)
For: Method for Multimedia Flow Transport) Confirmation No. 2502
)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Dear Sir:

Applicant requests reconsideration of the patent term adjustment in light of the recent *Wyeth v. Dudas* decision (D.D.C., Memorandum Opinion for Case No. 07-1492, Sept. 30, 2008).

Applicant agrees with the Office's Patent Term Adjustment of A delay minus Applicant Delay of 462 days. Based on a December 8, 2008 filing of an RCE, Applicant submits the B delay is 491 days. After taking A delay and B delay overlap into account, Applicant requests reconsideration of Patent Term Adjustment to **879** days total.

This request is accompanied by the fee required under 37 C.F.R §§ 1.18(e) and 1.705(b)(1). Please charge any underpayment or credit any overpayment related to this filing to Deposit Account No. 13-2490.

A. Definition of A Delay and B Delay

According to *Wyeth*, there are three guarantees of patent term under 35 U.S.C. § 154(b). The first, termed “A delay”, are extensions due to delays by the PTO beyond statutory deadlines, such as fourteen months for a first response on the merits, four months to issue an office action after a response, and four months to issue a patent after the fee is paid. *Wyeth*, p. 3. The second, termed “B delay”, is a “a one-day term extension [that] is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO” *Id.* The third, termed “C delays”, concerning delays due to interferences, secrecy delays and appeals was not substantively addressed by *Wyeth*. *Id.*

35 U.S.C. § 154 also reduces patent term adjustment due to delays by the applicant for the period of time where an applicant failed to engage in reasonable efforts to conclude prosecution of the application. 35 U.S.C. § 154(b)(2)(C)(i). Specifically, the statute defines failing to engage in reasonable efforts to conclude prosecution for any periods of time “in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.” 35 U.S.C. § 154(b)(2)(C)(ii).

For purposes of this request, A delay includes reduction in patent term due to delays by the Applicant.

B. Prosecution History Summary

The total patent term adjustment indicated on the Determination of Patent Term Adjustment for this application is 462 days. Key dates for this application are shown in the table below.

Date	Activity	A Delay	B Delay	Applicant Delay
February 5, 2002	Priority Date Established			
July 29, 2004	US National Stage Application Filed with USPTO			
August 5, 2004	Commencement of National Stage in US			
January 19, 2005	371(c) Requirements Fulfilled			
March 19, 2006	14-Month Date after 371(c) Requirements Fulfilled	+		
August 5, 2007	3-Year Date from Commencement of National Stage in US	+	+	
October 18, 2007	1 st Non-Final Rejection Mailed	+	+	
January 18, 2008	3-Month Date from Mailing of 1 st Non-Final Rejection		+	+
April 11, 2008	Response to 1 st Non-Final Rejection Filed		+	+
August 6, 2008	Final Rejection Mailed		+	
November 6, 2008	3-Month Date from Mailing of Final Rejection		+	+
December 8, 2008	Response to Final Rejection and RCE filed		+	+
February 23, 2009	2 nd Non-Final Rejection Mailed			
May 19, 2009	Response to 2 nd Non-Final Rejection Filed			
August 12, 2009	Notice of Allowance Mailed			
November 9, 2009	Issue Fee Paid			
December 22, 2009	U.S. Patent No. 7,636,375 Issued			

A “+” in the A Delay, B Delay, or Applicant Delay column in the table above indicates the Applicant believes the respective delay accrues between consecutive dates with “+” signs. For example, as shown in the table above, Applicant believes that A delay accrued between March 19, 2006 and October 18, 2007.

C. Calculation of A Delay and Applicant Delay

For the A delay and Applicant delay calculations, the Patent Term Adjustments (PTA) on PAIR for this application indicate a total of 462 days, including:

1. An A delay of 578 days from March 19, 2006 (the 14-Month Date from Fulfillment of the 35 U.S.C. § 371(c) Requirements) to the October 18, 2007 mailing date of the 1st Non-Final Rejection, which was the first action on the merits. Applicant agrees with the determination.
2. Applicant delay of 84 days between January 18, 2008 and April 11, 2008 for delay in responding to the 1st Non-Final Rejection. Applicant agrees with the determination.
3. Applicant delay of 32 days between November 6, 2008 and December 8, 2008 for delay in responding to the Final Rejection mailed on August 6, 2008. Applicant agrees with the determination.

Therefore, Applicant agrees with the Office that the A delay is 578 days, the Applicant delay is $84 + 32 = 116$ days, and thus the net PTA due to A delay minus Applicant delay is 462 days.

D. B Delay Calculation

The present application is a national stage filing under 35 U.S.C. § 371 of international application number PCT/FR03/00321, filed February 3, 2003, which claims the benefit of priority of French Patent Application No. 02/01333, filed February 5, 2002. The application was filed in the USPTO on July 29, 2004, and the national stage commenced on August 5, 2004, 30 months from the earliest claimed priority date of February 5, 2002. As set forth in 35 U.S.C. § 154(b)(1)(B), the start date for determination of B delay is "the actual filing date of the application in the United States." 37 C.F.R. § 1.702(b) explains the meaning of the term "actual filing date" as used in 35 U.S.C. § 154(b)(1)(B). PTO delay for a national stage application begins if the Office fails to issue a patent within three years after the date the national stage "commenced under 35 U.S.C. 371(b) or (f)."

As indicated above, the national stage commenced on August 5, 2004 and therefore the 3-Year Date from Commencement of National Stage in US is August 5, 2007. Thus, B delay began on August 5, 2007, as shown in the table above. As also shown in the table above, the B delay ended on December 8, 2008, when an RCE was filed. The interval from August 5, 2007 to December 8, 2008 is 491 days in length.

Applicant therefore submits the B delay is a total of **491** days.

E. Overlap of A Delay and B Delay

As detailed above, A delay accumulated between March 19, 2006 to October 18, 2007. As also detailed above, B delay accumulated between August 5, 2007 to December 8, 2008. Thus, A delay and B delay overlap (i.e., occur on the same calendar days) from August 5, 2007 to October 18, 2007 for a total of 74 days.

F. Requested Patent Term Adjustment

The *Wyeth* decision states that “the ‘A period’ and ‘B period’ overlap only if they occur on the same calendar day or days.” *Wyeth*, p. 8. Thus, according to the *Wyeth* decision, Applicant is entitled to both the A delay and the actual B delay minus any overlap which occurs on the same calendar days. As shown above, there is an overlap of 74 days between A delay and B delay. Thus, the total Patent Term Adjustment due to both A delay and B delay minus overlap is $462 + 491 - 74 = \mathbf{879}$ days. Applicant therefore respectfully requests that **the Patent Term Adjustment for this case be increased from 462 days to 879 days.**

Please contact the undersigned at (312) 913-3338 as needed to speed processing of this Request.

Respectfully submitted,

**McDonnell Boehnen
Hulbert & Berghoff LLP**

Date: December 23, 2009

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